

REMARKS

This is a reply to the Office Action mailed April 8, 2003, with a shortened statutory response period of three (3) months from the mailing date, extended one month by Petition filed herewith. The Commissioner is hereby authorized to charge any additional fees to Deposit Account number 02-1818.

Claims 1-64 are presently pending in the application. Claims 65 and 66 have been canceled. Claims 1-64 stand rejected and Applicants respectfully traverse these rejections.

I. Rejections Under 35 U.S.C §101

The Examiner has provisionally rejected claims 1-29, 65 and 66 under the judicially created doctrine of obviousness-type double patenting as being substantially duplicate to claims 98-128 of copending Application No. 10/021,692. Claim 1 is also provisionally rejected under 35 USC §101 as claiming the same invention as that of claim 119 of copending Application No. 09/953,979. Applicants have canceled claims 98-128 of copending Application No. 10/021,692, and have also amended claim 1 of Application No. 09/953,979. Accordingly, Applicants submit that all rejections under 35 USC §101 of the instant application are moot.

II. Rejections Under 35 U.S.C. §112

Claims 1 and 65 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants have amended claim 1(iii) to clarify the step of seeding. Applicants have canceled claims 65 and 66, thereby mooting the rejection of these claims. Accordingly, Applicants respectfully request a withdrawal of all rejections under 35 U.S.C. §112.

III. Rejections under 35 U.S.C. §103

The Examiner has rejected claims 1-66 under 35 U.S.C. §103 in view of Stainmesse et al. (U.S. Patent No. 5,133,908) and Cima et al. (U.S. Publication No. 2002/0048610). Applicants respectfully traverse these rejections.

The '908 Patent discloses a method for preparing a dispersible colloidal system of spherical particles having a size less than 500 nm. The method includes the steps of:

- 1) preparing a liquid phase of a substance in a solvent and a surfactant;

- 2) preparing a liquid phase of a non-solvent, the non-solvent being miscible in all proportions with the solvent;
- 3) the addition of the solutions of 1) and 2) with the other with moderate stirring to produce a colloidal suspension of nanoparticles; and
- 4) optionally removal of solvents.

The method of the '908 Patent appears to be limited to forming amorphous particles. The '908 Patent discloses in Example 14 that the disclosed process when carried out using indomethacin yields non-crystalline particles (Col. 8, lines 65-67).

Cima et al. discloses a method of producing crystalline materials using seed crystals. Because Cima discloses using seed crystals to form a crystalline particles, there is no motivation to combine Cima with the '908 Patent which is directed to forming amorphous particles. Accordingly, the '908 patent and Cima teach away from combining them. Thus, the Examiner has failed to state prima facie case of obviousness.

Accordingly, Applicants respectfully submit the pending claims are non-obvious, and patentable in view of the '908 Patent.

In view of the foregoing Amendments and Remarks, Applicants respectfully submit that Claims 1-64 are in condition for allowance and respectfully request early notice of the same.

Respectfully submitted,
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